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10/774,210	02/06/2004	Christian S. Nielsen	P0010937.00	6908
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924				
EXAMINER				
GEDEON, BRIAN T				
ART UNIT		PAPER NUMBER		
3766				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/774,210

## Applicant(s)

NIELSEN ET AL.

## Examiner

Brian T. Gedeon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 16-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment after non-final filed 30 April 2008. Claims 1-5 and 42 are pending; claims 16-41 are withdrawn, and claim 43 is new.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed concurrent with the amendment has been approved.

### ***Double Patenting***

3. The nonstatutory obviousness-type double patenting rejection against claims 1-15 has been withdrawn in view of the timely filed terminal disclaimer.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "structural enhancing elements within the anode" as claimed in claims 5 and 13, and the "holes" defined in the anode as claimed in claim 9, and the non-permeable film of claim 10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is indefinite how the anode "defines one or more holes." Do the holes pertain to "holes" as is known in semiconductor substrate technology in order to effect conductance, or are the holes related to bores created in the anode plates?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5, 6, 10-13, 42, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Pless et al. (US Patent no. 5,131,388).

In regard to claims 1, 2, 11, 12, 42 and 43, Pless et al. describe an implantable cardiac defibrillator with improved capacitors. Figure 2 shows the capacitor with anode plates 32 and cathode plate 34. The plates are sandwiched together such that an cathode plate 34 is disposed between a first and second anode plate. The plates 32 and 34 are separated from each other through paper separators 36; the paper medium is considered to be an insulative material, and electrically separates the anode from the cathode. The entire structure is sealed in an encasement 38. See column 3 lines 14-29.

In regard to claim 3, aluminum strips 41 serves as electrical contact with the anode, and aluminum strips 47 serves as electrical contact for the cathode, col 3 lines 45-50.

In regard to claims 5, 6 and 13, the anode is composed of a material that is comparatively stiff, col 3 lines 32-33, which is considered to enhance the structure of the anode since the "structural enhancing element" is intended to provide more structural support without significantly undermining the charge capacity.

In regard to claim 10, the encasement 38 is sealed by a polymeric envelope 46 (i.e., a non-permeable film) to prevent fluid leakage into the capacitor.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pless et al. (US Patent no. 5,131,388).

In regard to claim 4, Pless et al. substantially describe the invention as claimed except for the volumetric dimensions of the encasement and the location of the encasement parts. It would have been obvious to one with ordinary skill in the art at the time the invention was made since our reviewing courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). The location of parts has also been held to be within routine skill in the art. *In re Japiske*, 86 USPQ 70. Lastly, it has been held as obvious the duplication of parts (i.e., the first and

second encasements), since it only requires routine skill in the art. *St. Regis Paper Co., v. Bemis Co.*, 193 USPQ 8.

11. Claims 7, 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pless et al. (US Patent no. 5,131,388) in view of Jow et al. (US Patent no. 5,600,535).

In regard to claims 7, 8, 14, and 15, Pless et al. substantially describe the invention as claimed except for the use of the materials of tantalum compounds, titanium, and hydrous ruthenium oxide. Jow et al. describe an capacitor 10 composed of an anode and a cathode sandwiched together, and separated by an porous membrane. Jow et al. that the capacitor can be composed of materials comprising titanium, tantalum, etc, col 7 line 6 – col 8 line 3, and wherein it is also known to coat components of a capacitor with hydrous ruthenium oxide, col 1 lines 13-19 and 45-52. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the capacitor components of Pless et al. with the materials taught be Jow et al. since it has been held that within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use constitutes a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pless et al. (US Patent no. 5,131,388) in view of Hudis (US Patent no. 6,687,116).

In regard to claim 9, Pless et al. substantially describe the invention as claimed except for the holes defined by the anode. Hudis, in a similar field of endeavor, describes a capacitor wherein the anode is etched with micron sized holes in order to

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increase the effective surface area of the anode, col 4 lines 18-26. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the anodes of Pless et al. to include holes, as taught by Hudis, in order to increase the surface area of the anode since it is well known in the art that maximizing the surface area of an anode leads to maximization of the capacitance of the capacitor.

### ***Conclusion***

13. In view of the new grounds of rejection, this action is made **NON-FINAL**.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Gedeon whose telephone number is (571) 272-3447. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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